

## **REMARKS**

### **Status of the Claims**

Upon entry of the instant amendment, claims 1 and 5-17 remain pending in the above-identified application, with claims 1 and 5-10 standing ready for further action on the merits, and remaining claims 11-17 being withdrawn from consideration based on an earlier restriction requirement of the Examiner.

Claim 1 has been amended based on claim 5 and Figs. 1 and 2 of the present application. Claim 5 also has been amended so as to maintain consistency with amended claim 1.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. Further, the instant amendment does not raise substantial new issues for the Examiner's consideration nor require further search on the Examiner's part. At the same time, the instant amendments place the pending claims in condition for allowance and into a more proper format for issuance in a United States patent, by overcoming the outstanding rejection(s) of record.

As such entry of the instant amendment and favorable action on the merits are earnestly solicited.

### **Claim Rejection under 35 U.S.C. § 103**

Claims 1 and 5-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brownfield US '493 (US 6,306,493) as evidenced by JP '395 (JP 2003-013395), Rhodius DE '577 (DE 3431577), Doublet WO '937 (WO 03/097937), Doublet US '888 (US 6,402,888), Sundberg US '389 (US 5,989,389), and Crane US '617 (US 4,552,617).

Applicants respectfully traverse the rejection, and request reconsideration and withdrawal thereof based on the following considerations.

*Nonobviousness over the Combination of the Cited References*

It is alleged in the Office Action that the primary reference Brownfield US '493 discloses at columns 2 to 3 coating or laminating a marked web.

However, at best, Brownfield US '493 merely teaches coating of a raw paper. The coated finished paper is the product, which is laser-markable at best. Also, Brownfield US '493 fails to disclose or suggest embedding marks in layered webs so as to cover identification marks. Brownfield US '493 merely discloses ordinary paper coating techniques, where the coating step is conducted prior to the laser marking step. Thus, Brownfield US '493 fails to disclose or suggest that i) marks are made on a moving web, and then ii) the marks are covered or buried by a second layer (*i.e.*, the second moving web).

Also, Brownfield US '493 discloses at column 5, lines 27-31 as follows:

*The marked paper products and board products can moreover be subsequently printed and further processed, for example surface-coating, laminating or sealing, without adverse effect on their markability.* (Emphasis added)

However, the term "marked paper" in column 5, line 27 of Brownfield US '493 should be a typographical error and read "markable paper" since the paper is subject to further processing without affecting its markability in Brownfield US '493. It is proper interpretation to one skilled in the art that what is disclosed in Brownfield US '493 is preservation of the

markability of a “markable paper,” not “marked paper”. Otherwise, this disclosure does not make sense to one skilled in the art.

Further, the secondary reference JP ‘395 also fails to disclose or suggest the claimed features of the present invention. JP ‘395 merely discloses laser-made perforations in the middle layer of a multilayer paper product. The present invention is different from the invention of JP ‘395 in that the laser marks are made as dark areas by burning with laser beam. Moreover, the marking step and the subsequent laminating step are not disclosed or suggested in Brownfield US ‘493 even in view of JP ‘395.

The other secondary references (Rhodius DE ‘577, Doublet WO ‘937, Doublet US ‘888, Sundberg US ‘389, and Crane US ‘617) also fail to disclose or suggest the claimed features of the present invention. For example, the four (4) secondary references of Rhodius DE ‘577, Doublet WO ‘937, Doublet US ‘888 and Sundberg US ‘389 relate to various paper watermarking techniques in a paper machine. Crane US ‘617 discloses strips incorporated as a security feature within paper during papermaking. Making burned marks with laser and burying the marks in multilayer structure of the present invention are also not disclosed or suggested in the secondary references.

Therefore, there is no rationale and/or reasonable expectation of success based on the combination of the cited references, by which one skilled in the art could arrive at the present invention as claimed, since the cited references fail to disclose or suggest each of the instantly claimed features, as explained above. Thus, it is submitted that the present invention is not obvious over Brownfield US ‘493 even in view of the secondary cited references.

Based on the foregoing considerations, Applicants respectfully request that the Examiner withdraw the rejection.

**Conclusion**

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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